

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Peter M. Perthou
Serial No. : 09/752,015
Filed : December 29, 2000
Title : KEY RING

Art Unit : 3627
Examiner : Suzanne Dino Barrett
Conf. No. : 1179

Mail Stop Appeal Brief - Patents

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF FOR APPELLANT

I. THE EXAMINER'S ANSWER FAILS TO SUPPORT HER CONTENTION THAT THE NARROW DESIGN PATENT CLAIM CROSS READS WITH ALL THE CLAIMS IN THE UTILITY APPLICATION.

The Examiner's Answer, states:

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Design patent No. D435,720. Although the conflicting claims are not identical, they are not patentably distinct from each other because the design patent clearly shows all of the claimed structure of the instant utility patent application and the utility patent claims all of the structure shown in the design patent as evidenced by the identical drawings figures in both the utility application and the design patent. Accordingly, two-way obviousness determination is satisfied. P.p. 3.

...

Firstly, with respect to Applicant's arguments regarding the double patenting rejection, it is maintained that the drawing figure shown and claimed in design patent D435,720 covers the structure set forth in the claims of the instant application, and therefore, the two-way obviousness determination is satisfied. Applicant's arguments that the instant claim is broader does not overcome the rejection, since the structure of claim 1 is clearly shown in the drawings (and therefore claimed) in the design patent. Applicant has not claimed any limitation which is not shown in the drawings such as a particular material, flexibility, etc, which would overcome the rejection. P.p. 5.

...

With respect to Appellant's specific arguments regarding the double patenting rejection on page 4 of the brief, lines 8-10 particularly, it is maintained that the D435,720 design patent clearly teaches the structure of the claimed invention as recited in the claims. For example in claim 1, the drawing figure 1 of D435,720 9 as shown below clearly teaches a key holding ring at the bottom of the device, a band, a D-ring coupling the band to the key holding ring and the D-ring having a U-shaped portion engaging the key holding ring and a bar between

the ends of the U-shaped portion and engaging the band. Accordingly, Appellant's arguments are not persuasive. (Fig. 1 with BAND, BAR (ENGAGING BAND), U-SHAPED D-RING, KEY HOLDING RING label). P.P. 6-7.

The Examiner's Answer does not even mention the binding authorities of the Federal Circuit Court of Appeals set forth on page 4 of our Brief.

Nor has the Examiner set forth any construction of the narrow design patent claim and associated a construction of this claim with the construction of any claim in the utility application. See *Elmer v. ICC Fabricating, Inc.*, 36 U.S.P.Q. 2d 1417, 1420 (Fed. Cir. 1995).

She did not and can not set forth a construction of the narrow design patent claim that would cross read on the construction of at least claim 1 in the utility application or any other claim in the utility application.

II. CLAIMS 1, 6 AND 11 MEET THE CONDITIONS FOR PATENTABILITY UNDER 35 U.S.C. §103(a) OVER THE PRIMARY, SECONDARY AND EITHER TERTIARY REFERENCE, AT LEAST BECAUSE THE REFERENCES FAIL TO SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE LIMITATION OF THESE CLAIMS, AND THE EXAMINER'S ANSWER FAILS TO EVEN MENTION THE CONTROLLING AUTHORITIES OF THE FEDERAL CIRCUIT COURT OF APPEALS.

The Examiner's Answer, p.4, repeats verbatim the rejection in paragraph 4 of the final action and in the paragraphs spanning pages 5 and 6 repeats substantially verbatim the arguments advanced on pages 5-6 of the final rejection. We have dealt with this position on pages 5-8 of our brief.

The Examiner's Answer adds:

With respect to the rejection of claims 1,6,11 under 35 U.S.C. 103, Appellant's arguments on page 7 of the brief, first full paragraph, are not persuasive. The

Examiner clearly set forth the specific structure in the prior art which corresponds to the claimed structure, using reference numerals as shown in the grounds of rejection presented above.

With respect to Appellant's arguments on page 7, second full paragraph, it is maintained that Jung clearly teaches a conventional D-ring 14 having a bar (ends of the D-ring) formed with a gap to allow insertion of the spiral key ring 15.

With respect to Appellant's arguments on page 7, third full paragraph, it is maintained that the combination of references is proper since Jung clearly provides motivation for utilizing multiple rings.

With respect to Appellant's argument on page 8 of the brief regarding the method steps of claim 11, it is maintained that the method steps are inherent to the device taught by the combination of references. Since the prior art references are silent as to the desired assembly of the device, it is left to one of ordinary skill in the art whether an intermediate ring would have been utilized given the teachings of the prior art. The examiner maintains that such a construction would have been obvious to one of ordinary skill in the art. P.p.7-8.

The Examiner's Answer does not mention any of the binding authorities of the Federal Circuit Court of Appeals upon which we relied. If this ground of rejection were repeated, the Examiner was respectfully requested to associate each element in each rejected claim with corresponding elements in the references, and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of the claims. The Examiner did not and can not comply with this request.

III. CLAIMS 2-5 AND 7-10 MEET THE CONDITIONS FOR PATENTABILITY UNDER 35 U.S.C. § 103(a) OVER THE PRIMARY, SECONDARY, EITHER TERTIARY, AND QUATERNARY REFERENCE, AT LEAST BECAUSE THE REFERENCES FAIL TO SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE LIMITATIONS OF THESE CLAIMS.

The Examiner's Answer repeats verbatim, pp. 4-5, paragraph 5 of the final rejection to which we responded on pages 8 and 9 of our brief.

The Examiner's Answer added:

Furthermore, the Miller '137 patent clearly teaches a web band having most of its length fastened together and its ends clamped together and fastened by stitching as discussed above. In addition, Applicant's arguments regarding the method limitations of claim 11 are not persuasive. The assembly of the band, D-ring and key ring would have been considered inherent to the use of the device given the rejection of the structure of the device set forth above. Therefore, Applicant's argument that the Examiner has not provided sufficient motivation to combine these references is not persuasive. It is maintained that the discussion above, clearly sets forth the motivation to combine the elements set forth in Chen, Jung, Miller, Sheldon and Momemmers. P. 6.

...

Appellant's arguments regarding the rejection of claims 2-5,7-10 under 35 USC 103, specifically set forth on page 9, lines 1-8 of the brief, regarding the Miller reference are not persuasive. It is maintained that the Miller reference clearly teaches the use of stitching 16,30 on a band passed through a key ring 20. With respect to Appellant's argument on page 9, lines 9-10 of the brief, it is maintained' that the stitching 16,30 of Miller comprises the clamp.

With respect to Appellant's arguments on page 9, lines 11-16 of the brief, it is maintained that the stitching 30 (Fig.4) of Miller would have provided teaching such that one of ordinary skill in the art would have stitched together the band in any manner desired, including along most of the length of the web band member.

With respect to Appellant's argument on page 9, lines 17-21 of the brief, it is maintained that Jung clearly teaches a gap in the D-ring 14 to receive the spiral key ring 15.

Accordingly, it is maintained that the prior art of record is properly

combinable and teaches the structure and method of the instant claimed invention. P. 8-9.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in each references regarded as corresponding to each limitation in the rejected claims and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the limitations of these claims. The Examiner did not and cannot comply with this request.

CONCLUSION

In view of the authorities in our brief and set forth above, the reasoning in our brief and above and the inability of the prior art combinations of at least three references relied upon by the Examiner to make obvious the subject matter as a whole of the invention disclosed and claimed in this application, the decision of the Examiner finally rejecting all claims should be reversed. If the Board believes a claim may be allowed in an amended form, the Board is respectfully requested to include an explicit statement that such a claim may be allowed in such amended form and direct that Appellant shall have the right to amend conformity with such statement in the absence of new references or grounds of rejection.

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Page : 6

Attorney's Docket No. 08914-009001

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Respectfully submitted,
FISH & RICHARDSON P.C.

29 January 2007
Date: _____

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